UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,204	06/26/2001	Naoyuki Fujisawa	1538.1015	9335

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 March 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-19 have been examined. Application 09/891,204 has a filing date 06/26/2001 and foreign data 02/22/2001.

Response to Amendment

2.   In response to Non Final Rejection filed 12/06/2005, the Applicant filed an Amendment on 03/06/2006, which amended claims 1, 7 and 13. Applicant's amendment overcame the Section 112 1st rejection.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7, 13 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 7 and 13 recite "and a particular packet data to be sent; when a terminal of said destination user registered in said transmitting information storage device performs a processing to receive packet data, charging said destination user for said packet data, wherein said destination user is carried out without judging whether or not said packet data is the registered particular packet". The claims are indefinite because they create confusion distinguishing between a "particular packet data" and a "packet data". The Examiner does not know if the receive "packet data" is the "particular packet data" or another "packet data". Claim 19 recites "charging a destination user for received packet data regardless of particular packet data received

and transferring a communication fee charged to the destination user for the particular

packet data". Said claim is indefinite because it recites "regardless of particular packet

data" then it said "the particular packet data". The claim does not clearly teach what is

"the particular packet data".

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

Claims 1-3, 5-9, 11-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Meuronen (U.S. 6,473,622).

As per claims 1, 7, 13 and 19 Meuronen teaches:

A method for transferring a communication fee, comprising:

registering into a transmitting information storage device, information regarding

destination users, a sender, and a particular packet data to be sent (see column 1, lines

16-33; column 3, lines 35-42);

when a terminal of said destination user registered in said transmitting

information storage device performs a processing to receive packet data, charging said

destination user for said packet data (see column 1, lines 1-16; column 5, lines 1-15),

wherein said charging *said destination user* is carried out without judging whether

or not said packet data is registered particular packet data (see column 6, lines 19-36;

column 7, lines 15-24); and

transferring the communication fee charged to said destination users for said

particular packet data, to said sender registered in said transmitting information storage

device, by using a receiving status data for said particular packet data to be received by

said terminals of said destination users registered in said transmitting information

storage device (see column 2, lines 60-67; column 7, lines 14-24),

wherein a number of packets of said particular packet data is calculated from

said particular packet data stored in said transmitting information storage device (see

column 6, lines 19-35; column 7, lines 13) but does not expressly teach and an amount

of the transferred communication fee is calculated by using a number of destination

users specified by said receiving status data, and said number of packets of said

particular packet data. Meuronen teaches in column 7, lines 13-23 "information on the

fact that chargeable information was concerned directed the billing associated with the

short message to the subscriber, but it is obvious to those skilled in the art that by the

solution of the invention, billing may also be directed to another address. For example

an ad that the subscriber is prepared to receive, could be directed to a third address by

means of the described solution by adding parameters, whereby the advertiser would

have to pay only for information relayed by an operator and received directly by a

customer". Therefore, it would have been obvious to a person of ordinary skill in the art

at the time the application was made, to know that the advertisers' fees charge for

transmitting messages to destination users would be directly proportional to the number of messages (i.e. packet data) that are delivered to said destination users. The bigger the number of messages sent by said advertisers that are relayed by an operator and received directly by said destination users, the more said advertisers (i.e. sender) would have to pay to cover the expenses of said distribution.

As per claims 2, 8 and 14, Meuronen teaches:

The method set forth in claim 1, further comprising:

charging said sender for said particular packet data when said particular packet data is transmitted to the destination users registered in said transmitting information storage device (see column 7, lines 13-24).

As per claims 3, 9 and 15, Meuronen teaches:

The method set forth in claim 1, wherein said registering comprises:

registering information regarding said sender and said particular packet data to be sent into said transmitting information storage device; and registering information regarding said destination users into said transmitting information storage device (see column 3, lines 35-42; column 7, lines 13-24).

As per claims 5, 11 and 17, Meuronen teaches:

The method set forth in claim 1, wherein said transferring comprises:

performing a processing to exempt particular destination users whose terminals are confirmed to have performed said processing to receive said particular packet data among said destination users registered in said transmitting information storage device from the charge for said particular packet data (see column 5, lines 1-15); and

performing a processing to charge said sender registered in said transmitting information storage device for a fee of said particular packet data for said particular destination users whose terminals are confirmed to have performed said processing to receive said particular packet data among said destination users registered in said transmitting information storage device (see column 7, lines 13-25).

As per claims 6, 12 and 18, <u>Meuronen</u> teaches:

The method set forth in claim 3, wherein said transferring further comprises:

acquiring data regarding said particular packet data which does not reach (see column 7, lines 13-25); and

specifying destination users who is confirmed to have performed said processing to receive said particular packet based on said data regarding said packet which does not reach (see column 7, lines 13-25).

5.   Claims 4, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Meuronen</u> (U.S. 6,473,622) in view of <u>Jacobs</u> (US 2004/0039784).

As per claims 4, 10 and 16, <u>Meuronen</u> teaches:

The method set forth in claim 3, but fails to teach wherein said particular packet data includes a Web page data, and said registering information regarding said destination users includes a step of registering information regarding said destination user that is acquired when a terminal of said destination user requests said particular packet data. However, <u>Jacob</u> teaches a system where users request and receive e-mails and advertisements using said users' mobile terminals (i.e., cellular phones with built-in web browsers; see paragraph 31). <u>Goldhaber</u> teaches a system that

compensates users for viewing advertisements by billing advertisers (see <u>Goldhaber</u> column 10, lines 39-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that <u>Meuronen</u> would use the system taught by <u>Jacob</u> to allow users of mobile terminals to request and receive e-mails and advertisements in said mobile terminals, where the sender (i.e. advertiser) and not the receiver (i.e. destination user) of said advertisements would be billed for said distribution. The feature of advertisers compensating users for viewing advertisements would make said users more willing to accept said advertisements, as said users would not be charged for said viewing.

Response to Arguments

6.   Applicant's arguments filed 03/06/2006 have been fully considered but they are not persuasive. The Applicant argues that <u>Meuronen</u> does not discuss packets because advertisements are not necessary packet data and that merely because packet data can include advertisements, does not teach that advertisements are packets. The Examiner answers that if Applicant's specification page 4, paragraph 2 teaches that "particular packet data includes advertisements" then an advertisement can be properly be constructed to be a "particular packet data". Therefore, <u>Meuronen</u> teaches "packet data", as defined by Applicant's specification.

The Applicant argues that <u>Meuronen</u> does not teach a packet as defined by the NIHnet handbook. The Examiner answers that <u>Meuronen</u> teaches a packet as defined by Applicant's specification page 4, paragraph 2.

The Applicant argues that since transmission bit rates may be different, a billing system that charges based on a number of connections does not teach a charging based on a number of packets. The Examiner answers that Applicant's specification defines packets as advertisements (see page 4, paragraph 2) and Meuronen teaches billing advertisers for the number of ads transmitted to subscribers (see column 7, lines 13-23). Therefore, Meuronen teaches charging based on a number of packets.

The Applicant argues that Meuronen does not teach a number of destination users specified by receiving status since Meuronen carries out charge processing and transfer processing per each connection. The Examiner answers that Meuronen teaches in column 7, lines 12-30 billing subscribers for received packet data. Therefore, Meuronen teaches number of destination users which are the subscribers.

The Applicant argues that Meuronen does not teach registering destination users, a sender and particular packet data to be sent. The Examiner answers that Meuronen teaches in column 3, lines 35-40 that "subscriber registers in the GSM system. Also, Meuronen teaches in column 7, lines 13-22 that is inherent that to bill an advertiser that sends an ad to a subscriber, said advertiser needs to be registered with the system and also is inherent that for an advertisement to be prepared to be received by a subscriber, said advertisement needs to be registered in the Meuronen system for said ad to be transmitted to said subscriber.

.The Applicant argues that claim 1 recites "charging said destination user is carried out without judging whether or not said packet data is the registered particular packet data" and that this charging does not need any checking to change the

processing. The Examiner answers that if <u>Meuronen</u> needs to do any checking or not to change the processing would still not matter, as <u>Meuronen</u> teaches in column 1, lines 35-47 billing subscribers for message received.

The Applicant argues that in <u>Meuronen</u> the primary charging destination is the sender but in the Applicant's claimed invention, the primary charging destination is the receiver. The Examiner answers that <u>Meuronen</u> teaches in column 7, lines 13-27 that the primary charging destination user is the subscriber but the sender or advertiser can also be charged for the advertisements delivered to the subscribers.

With respect to claim 2, the Applicant argues that the sender in <u>Meuronen</u> is not charged. The Examiner answers that <u>Meuronen</u> teaches in column 7, lines 13-23 that the sender or advertiser is charged for transmitting ads to a subscriber.

The Applicant argues that Applicant's claim 2 the sender is charged twice. The Examiner answers that nowhere in Applicant's claim 2 is mentioned or disclosed that the sender is charged twice.

The Applicant argues regarding claims 4, 10 and 16 that <u>Meuronen</u> does not teach a billing system of transmitted data based on destination user requests of "particular packet data". The Examiner answers that contrary to Applicant's argument, <u>Meuronen</u> teaches in column 7, lines 13-23 billing advertisers and/or subscribers for ads received by said subscribers.

The Applicant argues that <u>Meuronen</u> does not teach that both receiver and sender are charged, and a sender is only charged for the receiving fee. The Examiner answers that <u>Meuronen</u> teaches in column 7, lines 12-30 "directing the billing

associated with the short message to the subscriber...advertisers would have to pay only for information relayed by an operator and received directly by a consumer". Therefore, <u>Meuronen</u> teaches billing the receiver (i.e. subscriber) and the sender (i.e. advertiser).
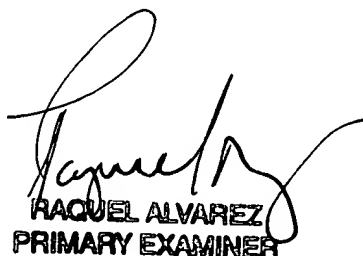
Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
May 6, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER